

## REMARKS

Claims 13-14, 16-20, 24, 28, 40, 42-43, and 45-49 have been amended; claims 11-12, 22, and 51 are canceled; claims 1-10, 30-39, and 59-73 are withdrawn, claims 23, 52, and 53 were previously presented, and claims 15, 21, 25-27, 29, 41, 44, 50, and 54-58 are original claims. The Applicant submits that the amendments made herein are fully supported in the specification, claims and the drawings, as originally filed, and therefore no new matter has been introduced. Claims 13-21, 23-29, 40-50, and 52-58 are subject to examination and pending in the present application.

### **I. Objection to Claims 20-21, 23, and 25-27**

The Examiner objected to claims 20-21, 23, and 25-27. Claim 20 has been amended to insert "of" between "a portion" and "the electronic book" in response to this objection.

If any additional amendment is necessary to overcome this objection, the Examiner is requested to contact the Applicant's undersigned representative.

### **II. Rejection of Claims 13-19, 40-50, 52, and 54-58**

Claims 13-19, 40-50, 52 and 54-58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla and further in view of Kuno. To the extent that this rejection applies to the claims, as amended, the Applicant respectfully traverses the rejection as follows.

Applicant respectfully notes that independent claims 13, 40 and 42 have been amended and recite a viewer having a plurality of hardware screens capable of being connected and disconnected. None of the cited references

discloses or suggests a method for displaying at least one selected page of an electronic book displayed on a viewer having a plurality of hardware screens capable of being connected and disconnected, as claimed in amended claims 13, 40 and 42. Therefore, the Applicant respectfully submits that amended claims 13, 40 and 42 are allowable over the cited prior art for at least this reason. As amended claims 13, 40 and 42 are allowable, claims 14-19, 41, 43-48 which depend from claims 13, 40 and 42, are likewise allowable.

Claim 49, as amended, recites displaying the content from the information source as an inset image within the displayed portion of the electronic book. None of the cited references discloses or suggests at least the feature of displaying the content from the information source as an inset image within the displayed portion of the electronic book, as claimed in amended claim 49.

Therefore, the Applicant respectfully submits that amended claim 49 is allowable over the cited prior art for at least this reason. As amended claim 49 is allowable, claims 50, 52, and 54-56 which depend from claim 49, are likewise allowable.

Claim 57 recites a page format module that formats the page of the electronic book to display a portion otherwise concealed by the inset image. The Applicant submits that none of the cited prior art teaches or suggests at least the feature of a page format module that formats the page of the electronic book to display a portion otherwise concealed by the inset image.

Therefore, the Applicant respectfully submits that claim 57 is allowable over the cited prior art for at least this reason. As claim 57 is allowable, claim 58, which depends from independent claim 57, is likewise allowable.

**III. Rejection of Claim 20-21, 23, and 25-29**

Claims 20-21, 23, and 25-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla. To the extent that this rejection applies to the claims, as amended, the Applicant respectfully traverses the rejection as follows.

Claim 20, as amended, recites a method for simultaneously displaying on a viewer a selected portion of an electronic book and content from an information source, comprising, in part, displaying the content from the information source as an inset image within the displayed portion of the electronic book.

The Applicant submits that none of the cited references discloses or suggests at least the feature of displaying the content from the information source as an inset image within the displayed portion of the electronic book, as claimed in amended claim 20.

The rejection refers to the pile of documents as the information source, and Lucas does not disclose or suggest showing a portion from the pile as an inset image within the displayed portion of an electronic book. The alleged information source is displayed in various pile configurations, not as an inset. Cassorla does not cure this deficiency in Lucas.

Therefore, the Applicant respectfully submits that amended claim 20 is allowable over the cited prior art for at least this reason. For similar reasons, the

Applicant submits that claim 28, as amended, is allowable over the cited prior art. As amended claims 20 and 28 are allowable, claims 21, 23, 25-27 and 29 which depend from claims 20 and 28, are likewise allowable.

#### **IV. Rejection of Claim 24 and 53**

Claims 24 and 53 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas in view of Cassorla and further in view of Levine. To the extent that this rejection applies to the claims, as amended, the Applicant respectfully traverses the rejection as follows.

Claim 24 of the present application, as amended, recites a method for simultaneously displaying on a viewer a selected portion of the electronic book and information from an information source comprising in part displaying a portion of an electronic book as wrapping around displayed content from the information source.

The Applicant submits that none of the cited prior art teaches or suggests at least the combination of displaying on a viewer a selected portion of the electronic book and information from an information source comprising in part displaying the portion of the electronic book as wrapping around the displayed content from the information source, as claimed in amended claim 24. The rejection cites Levine as disclosing "automatically wrapping a word to the next line, when a typing cursor comes close by to margins found in a document." The Applicant submits that there is nothing in either of the references that discloses or suggests displaying the portion of the electronic book as wrapping around the

displayed content from the information source, as claimed in claim 24, as amended.

Therefore, the Applicant respectfully submits that, at least for this reason, amended claim 24 is allowable over the cited prior art for at least this reason. For similar reasons, the Applicant submits that claim 53 is allowable over the cited art. As claim 53 is allowable, claims 57-58 which depend from independent claim 53, are likewise allowable.

#### **V. Insufficient Motivation to Combine**

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re

Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

Regarding the rejection of claim 24, The rejection merely states that it would have been obvious to combine the cited references to wrap text around the document contents because Levine teaches automatically aligning the text in accordance with pre-established margins. There is no suggestion, other than Applicant's disclosure, to employ this scheme to display the portion of an electronic book as wrapping around displayed content from an information source.

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 4, 7, 8, and 10. This is an insufficient showing of motivation.

### **CONCLUSION**

For all of the reasons set forth above, the Applicant respectfully submits that each of claims 13-21, 23-29, 40-50, and 52-58 recite subject matter that is neither disclosed nor suggested in the applied art of record. The Applicant also submits that the subject matter is more than sufficient to render the claims non-obvious to a person of ordinary skill in the art, and therefore respectfully requests that claims 13-21, 23-29, 40-50, and 52-58 be found allowable and that this application be passed to issue.

If for any reason, the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact

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the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper has not been timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension,

together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300 referencing Attorney Docket No. 026880-00020.

Respectfully submitted,



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